

Serial No. 10/633109
Attorney/Agent Docket No. AGYT-017CIP2 (PC19514C)

REMARKS

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I. Status of the Application

This paper responds to a non-final office action mailed August 23, 2006. The application was originally filed with Claims 1-13. In response to the non-final office action, Applicants have amended Claims 1 and 7, canceled claims 3, 5, 6, 8-13, without prejudice or disclaimer. Claims 1, 2, 4, and 7 are pending in this application.

By action taken here, Applicants in no way intend to surrender any range of equivalents beyond that needed to patentably distinguish the claimed invention as a whole over the prior art. Applicants expressly reserve all such equivalents that may fall in the range between Applicants literal claim recitations and combinations taught or suggested by the prior art.

II. Time for Reply

This paper responds to a non-final office action which was mailed May 23, 2006. The non-final office action set a three month shortened statutory period for reply from the mailing date, making the response due on or before Wednesday, August 23, 2006. Applicants are filing this paper on August 23, 2006.

III. Oath or Declaration

The Office alleges that the oath or declaration is defective because the date of execution is missing. Applicant respectfully submits that the current oath or declaration filed with the application is in compliance with the law and rules of the USPTO, thus a supplemental oath or declaration under 37 CFR §1.67(a) need not be filed. Applicant refers the Examiner to 37 CFR §1.63 and also to MPEP 602.05 which states that the date of execution of the oath or declaration is not required. Applicant respectfully requests that this objection be withdrawn.

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IV. Information Disclosure Statement (IDS)

Applicant confirms that the IDS as submitted was a copy of the IDS provided to the USPTO from application 10/246,837, which was the parent application of this application. The parent was subsequently abandoned.

V. Claim Objections

Claim 3 was objected to for minor informalities. Claim 3 has been canceled. Claims 8-13 were rejected as being improper dependent claims for failure to further limit the subject matter of a previous claim. Applicant has canceled Claims 8-13. Applicants respectfully request that these objections be withdrawn.

VI. Obvious Double Patenting

The Office Action rejected the original claims 1-13 as being unpatentable for nonstatutory double patenting based on US Patent No. 6,521,414 to Melcher, et al., issued on February 18, 2003. Applicant will file a terminal disclaimer upon allowance of the pending claims, as amended.

VII. Claim Rejections - Indefiniteness

The Office Action has made numerous rejections based on 35 USC §112, second paragraph, as allegedly being indefinite. These rejections are each discussed separately below.

The Office Action rejected original Claim 1 for failure to define the "metes and bounds" of the invention as it is alleged that the term "on a substrate" is broad and undefined. To expedite prosecution, original independent Claim 1 has been amended to delete "on a substrate". Accordingly, Applicants respectfully request that the rejection be withdrawn.

Further, the Office Action rejected original Claims 7-13. It is alleged in the Office Action that the term "difference" is indefinite in that there could be a decrease or an increased in NMDA-R phosphorylation. Applicants respectfully maintain that the term is

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definite and that skilled artisans understand the meaning of the term relative to receptor modulation. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Further, the Office Action rejected original Claim 8 for failure to define the "metes and bounds" of the invention as it is alleged that the term "a protein complex" is broad and undefined. To expedite prosecution, original dependent Claim 8 has been canceled. Accordingly, Applicants respectfully request that the rejection be withdrawn and maintain that all pending claims, as amended, are not indefinite under 35 USC §112, second paragraph.

VIII. Claim Rejections - 35 USC §102(b)

The office action rejected original Claims 1-5 under 35 USC §102(b) as being anticipated by Wang, et al., Nature, Volume 369, p233-235, published May 19, 1994. Applicants submit that Wang does not anticipate the claims of the present invention because it does not teach each and every element of the present claims. According to In re Verdegaal Brothers, 814 F.2d 628, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." The present application claims a method for identifying an agent that modulates the phosphatase activity of PTP or binding of PTP to NMDA-R. Wang does not describe modulating phosphatase activity of PTP or modulating the binding activity of PTP. Instead, Wang describes a method for modulating NMDA-R whole-cell currents and potentiation with known inhibitors of PTK and PTP. Since each and every element of the claimed invention has not been described in the reference, Applicants respectfully request withdrawal of the anticipatory rejection.

The office action rejected original Claims 1-13 under 35 USC §102(b) as being anticipated by Grant, et al., WO 97/46877, published December 11, 1997. Applicants submit that Grant does not anticipate the claims of the present invention because it does not teach each and every element of the present claims. The present application describes

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a method for identifying an agent capable of modulating phosphatase activity of PTP or for modulating the binding of PTP to NMDA-R. Further, the present invention describes the use of substantially pure or recombinantly expressed proteins. Grant does not describe modulation of phosphorylation of PTP or modulation of the binding of PTP to NMDA-R by an agent. Instead, Grant describes the activity of an agent to modulate signaling capacity or activity of a NMDA-R signaling complex or a component of the complex thereof. Further, Grant does not describe the use of substantially pure or recombinant proteins. Instead Grant describes the use of whole cell extracts and hippocampal slice preparations. Since each and every element of the claimed invention has not been described in the reference, Applicants respectfully request withdrawal of the anticipatory rejection.

Wang does not describe modulating phosphatase activity of PTP or modulating the binding activity of PTP. Instead, Wang describes a method for modulating NMDA-R whole-cell currents and potentiation with known inhibitors of PTK and PTP. Since each and every element of the claimed invention has not been described in the reference, Applicants respectfully request withdrawal of the anticipatory rejection.

IX. Obviousness

Based on the aforementioned Wang and Grant references, Applicants respectfully submit that the present invention is not obvious in view of these references. As set forth in MPEP §2143, "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20

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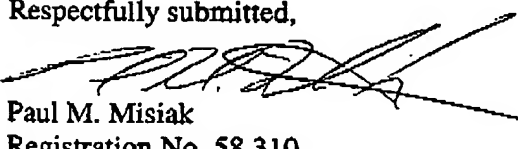
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USPQ2d 1438 (Fed. Cir. 1991).” As the Federal Circuit has also stated, “[a] general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” In re Deuel, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995). As set out above, Wang fails to describe either the modulation of the phosphatase activity of the PTP with NMDA-R or the binding of PTP to NMDA-R. Grant fails to describe the modulation of phosphatase activity of PTP or the effect of modulating PTP binding to NMDA-R except as related to a NRSC. As such, Wang et al. and Grant et al., alone or in combination, fail to describe the claimed limitation of identifying an agent capable of modulating the phosphatase activity of a PTP or for modulating the binding of PTP to NMDA-R. Accordingly, there can be no motivation to combine what has not been described in either of the cited references. Therefore, the claimed invention is non-obvious under 35 U.S.C. § 103(a) over the cited references. Applicants respectfully submit that the present invention is patentable under 35 U.S.C. §103(a).

X. Conclusion

Based on the foregoing, Applicants respectfully submit that the present application is in condition for allowance. If Applicants have overlooked any other fees required in connection with the filing of this paper, please charge deposit account number 23-0455.

Respectfully submitted,



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